

Office Action Summary

Application No.

09/1779,588

Applicant(s)

LEVY

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 08/15/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 57-68 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 57-68 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed subject matter "A coating formed on the surface ... lubricant" of claim 57 (and its dependent claims) is not properly described in the application as filed and consequently raise doubt as to applicant's possession of the claimed invention at the time of filing on the instant application. After a careful review of the instant application disclosure and examples, the examiner have found that applicants' disclosure is to "a method of lubricating a surface comprising coating the surfaces with a lubricant composition", note the second paragraph found on page 20 of the instant application. Applicant have made numerous disclosure to lubricant compositions, note paragraph 3 of page 29, but there is no specific reference to "a coating formed on the surface of a substrate". Applicants discloses that the lubricant composition can be shaped by any conventional molding or extruding process to form discs, sheets, rods, blocks, powders, or filaments, and especially solid lubricant compositions that can be formed to the contours of the surface or surfaces that are being lubricated, note the first full paragraph on page 30. Applicant's examples for the said lubricant compositions or devices for use as solid and/or liquid lubricants can include washers, friction reducing plates, pads, composites,

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agglomerates, bearings, shock absorbers/struts/pressure pad/impact plates, shims and spacers; seals; and gels or greases, note pages 37-38. The examiner did not find any explicit disclosure for claim 61 "the substrate comprises a cable", for "claim 62 the substrate comprises a wire" nor for "claim 58 the superabsorbent polymer absorbs greater than 100 times its weight in water and desorbs water when the coating is dried". The disclosure bridging pages 22-23 discloses that the superabsorbent polymer employed according to the instant claimed invention, absorbs from about 25 to greater than 100 times its weight in water and comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile or acrylamide, including copolymers thereof or starch graft polymers thereof, or mixtures, wherein the mixtures contain from 2 to about 3 or 4 superabsorbent polymers. Applicant is invited to point out to the examiner the locations of the said subject matters in the instant application.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. In re Glass, 429 F.2d 1228, 181 USPQ 31 (CCPA 1974).

Applicants attention is directed to the various sections of the MPEP:

608.01 (p)	Completeness (R-1),
702.01	Obviously Informal Case,
201.07	Continuation Application, and
201.08	Continuation-in-Part Application.

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Claims 57-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed subject matter "A coating formed on the surface ... lubricant" of claims 57 (and its dependent claims); "the superabsorbent polymer absorbs greater than 100 times its weight in water and desorbs water when the coating is dried" of claim 58; "the substrate comprises a cable" of claim 61, and "the substrate comprises a wire" of claim 62 are not enabled by the specification and raise doubt of enablement. The said claimed limitations were not described in the instant application disclosures and examples for the reasons discussed in the above rejection.

In view of the rejection of the claims as failing to define the invention in the manner required by 35 U.S.C. 112, no search by the examiner have been made.

Applicant's arguments filed August 15, 2001 have been fully considered but they are not persuasive.

Applicant has requested the Examiner to explain how conducting the process of lubricating a surface does not result in obtaining a lubricated surface. The Examiner directs Applicant's attention to the instant drafted independent claim 57 which is set forth below verbatim and request Applicant to point out in the instant disclosure where the explicit steps for a process of lubricating a surface are set forth as claimed in the instant drafted claims.

"Claim 57. A coating formed on the surface of a surface of a substrate, said coating comprising a superabsorbent polymer further comprising a lubricant."

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Applicant makes on record in the third paragraph on page 2 of the response that pages 6-19 of the written description describe these various lubricants which include petroleum lubricants (and lubricant additives), synthetic lubricants, greases, solid lubricants and metal working lubricants. The Examiner is confused about Applicant's admission made in the response in that the paragraph on page 19 of the instant application is titled Summary of the Invention. Following in the second paragraph on page 20 of the instant application reads as follows:

“The invention also comprises a method of lubricating a surface comprising coating the surface with a lubricating composition comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces as described herein; however, the method of the invention includes the use of water or oil as lubricants as well as other lubricants either with or without additives as described herein.”

It is unclear to the Examiner how this broad statement under the Summary of the invention qualify as support for a process of lubricating a surface. Applicant has not pointed to any other location in the instant application wherein any explicit steps for a process is being conducted and the Examiner did not find any during the examination of the instant application. Applicant also make admission on record at the third paragraph of page 2 of the response that page 12 states that these lubricants are used on cables, and page 17 states that these lubricants are used on wires, but applicant do not state that any process is being conducted. A statement of use is clearly not a process step. Applicant has not provided the Examiner with any process steps that are explicitly set forth in the instant disclosure for explicit process steps for coating claim 61

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cable, nor for coating claim 62 wire, nor for claim 58 superabsorbent polymer absorbs greater than 10 times its weight in water, and that the superabsorbent polymer desorbs water when the coating is dried.

Applicant state that page 31 and 32 describe a method for combining the superabsorbent polymer with the lubricant and additive, when employed, by using water or high humidity... desorbs water upon drying. The Examiner have reviewed pages 31 and 32 and did not find any explicit disclosure directed to a process for coating a wire nor coating a cable. The Examiner maintains the position stated of record that the subject matter of claim 57 and its dependent claims was not described in the instant application (specification) in such a way as to enable one skilled in the art to which it pertains, or which it is most nearly connected, to make and/or use the invention and raise doubt of enablement. The said claimed limitations were not described in the instant application disclosures and examples for the reasons discussed in Paper No. 5, dated July 27, 2001.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

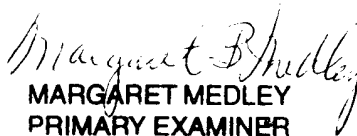
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday to Friday from 7:30 PM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Medley/

10/22/01


MARGARET MEDLEY
PRIMARY EXAMINER